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EXAMINER

SAGER, MARK ALAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/725,694 | Applicant(s) YOUNG ET AL. | |
| | Examiner M. Sager | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,17-24,42-44 and 47-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13,17-24,42-44 and 47-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 6-13, 17-24, 53-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention as maintained from action mailed April 18, 2003 in s/n 09/605070 for process as restated below. To be clear, each of the cited functions are new matter that is not supported by originally filed specification contrary to citations stated in paper rec'd Dec 1, 2003 as would have been interpreted by an artisan at time of filing and thus each cited feature must be cancelled from claims in reply.

The functions regarding 'responsive to the current state indicating that a time limit for performing the conditional action has been exceeded, automatically transmitting new episodic content' (clm 10) and 'determining whether an amount of time for completing a stage in the game episode has been exceeded, and if so, [automatically] transmitting an episodic game module' (clms 54-58) since there is no support to transmit content to user when time limit to perform a conditional action is exceeded such as user not performing action within time limit or for plurality of user's to reach same points in game when users start playing at different times for different duration of play and thus function is inventor continuing to invent after filing.

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The specification fails to reasonably convey to an artisan at time invention was filed that Applicant possessed the claimed invention regarding 'to ensure that the [plurality of] users reach the same points/stages in the game at approximately the same time' (clms 53-58) at least in part since there is no process disclosed for every user to start/stop at same time thus users start play at different times, users have differing time available to play and where different users have different ability level to thereby not be at same point at approximately same time; thereby, the function is new matter as inventor continuing to invent after filing. Although paragraph 12 states in part 'The conditions may be predicated on a user accomplishing a task... be time based, to ensure that all players reach the same points in the game at approximately the same time'; there is no teaching that every player must start at approximately same time and play for same duration in order to reach same points/stages in game at approximately same time where disclosure appears to make mini-game episodes [expansions] available on a periodic basis whereby different users access game episodes at different times to include different day, week, or longer process within originally filed specification that reasonably conveys to an artisan that Applicant was in possession of invention and thus function is inventor continuing to invent after filing.

Further, 'altering the... storyline content to include a current real-world event, ... after... as the at least one user... module' (clms 1, 7, 42-43) includes providing real world event during play of a current episodic module that is not supported due to originally filed disclosure teaching incorporating real world event content into a next (i.e. subsequent) installment of the game (6:1-6, 12:7-21, 16:22-17:3, 28:9-12) thereby teaching delivery of reference to real world event in a sequel episodic module where the reference is provided in transmittal during current module and thus the claimed function is new matter as inventor continuing to invent after filing.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 6-9, 42-43 and 47-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The method (clms 53, 55 and 58) is indefinite and confusing for being unclear as to process to ensure plurality of users reaches same points/stages in game at approximately same time since scope of approximately is not defined especially where only a portion of the complete story line content is currently available refers to that portion of storyline that is published while remaining portion of storyline in development is not available, where different users access game to start playing at different times, play for different durations and have different skill/ability in that there is no process that every player may only access a same episodic game module at same time, must play for same duration so as start at approximately same time, play for a set duration and stop at approximately same time to ensure that every player reaches same points/stage in game at approximately same time. In addition, the scope of approximately same time is unclear in relevance to prior game episodes where new players start playing an earlier game episode days, weeks or later than current game episode such that other users are playing a current game episode while another user is starting the first game episode that clearly confuses scope of approximately. Claim 1, 7, 42-43 recites the limitation "the complete" in lines 5, 4, 5 and 8 respectively. There is insufficient antecedent basis for this limitation in the claim. Claim 42-43 recites the limitation "the remaining" in lines 10 and 11 respectively. There is insufficient antecedent basis for this limitation in the claim. Also, computer readable medium of claim 50 conflicts with claim 1 due to module is transmitted to user in line 12.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10, 18, 24, 44, 53-56 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiels (6222925). Regarding claim 10, as would have been interpreted by an artisan, Shiels discloses a network 20 comprising a content server 18, a plurality of connected user computers (abstract, 1:39-2:62, 3:20-35, 3:39-60, 8:47-60, figs 1-8), a method of providing internet enabled game including all features including a plurality of episodes related to a storyline made available serially on a periodic basis (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:60, figs 1-8, esp. 7:62-8:2, i.e. on a regular basis) comprising steps implemented in a computer system of providing access to an initial episodic content module (5:12-18, 5:49-8:60, ref 70), altering the storyline arc such as delete, extend or combine storyline content based on popularity of branch or episode (7:62-8:60, ref 126), creating new episodic content related to the altered storyline arc (7:62-8:60, ref 126), responsive to current state indicating that a conditional action has been performed, enabling new episodic content to be accessed (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:60, figs 1-8), responsive to current state indicating that a time limit for performing action has been exceeded, automatically transmitting new episodic content to user such that the plurality of users reach same points in game at approximately same time (4:40-8:2,

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figs 1-8), wherein current state information comprises a user action (4:40-8:46, figs 1-8), wherein an episode is available responsive to determining whether user has submitted payment (4:40-8:2, figs 1-8). Regarding claim 44, as would have been interpreted by an artisan, Shiels discloses a method for providing or delivering [entertainment] content comprising a storyline for an electronic game from the content server to at least one user (supra), including the steps implemented in the content server of receiving a request from a user to gain access to an episode of the electronic game (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8), delivering an episode of the electronic game to the user (4:40-8:46), determining a date for the request received from the user (abstract, 1:39-2:62, 4:53-8:46) and permitting access to the requested episode responsive to the determined date being within permitted window for delivery (5:43-8:60, figs 1-8). Regarding claims 53-56 and 58, as would have been interpreted by an artisan, Shiels discloses a method (supra) including implementing in the content server the storyline content into a plurality of episodes (abstract, 1:39-2:62, 4:40-8:46, figs 1-8, i.e. define nodes/narrative), implementing the episodes into a sequence of episodic modules (abstract, 1:39-2:62, 4:40-8:46, figs 1-8, esp. 6-7A), for each user, transmitting one or more game modules to user's computer on a conditional basis such that only a portion of the storyline content is currently available (1:39-2:62, 4:53-5:6, 6:17-8:60, figs 1-8), determining whether an amount of time for completing a stage has been exceeded and if so transmitting an episodic game module, such that the plurality of users reach the same points in the game at approximately same time (4:53-5:6, 6:17-8:60, esp. 6:65-7:2, figs 1-8), determining whether the user has accomplished a task and if so permitting access to next episodic game module (supra, i.e. providing payment or PIN/access code, access at particular time/date such as holiday).

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7. Claims 1, 7, 42-43, 47 and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Sinclair (6554707). As would have been interpreted by an artisan, Sinclair discloses a network 306 comprising a content server 310, 508, 510, a plurality of connected user computers (abstract, 1:49-2:50, figs 1-19), a method of delivering content comprising all features including a storyline for a reality based game from the content server to at least one user (abstract, 1:49-2:50, 4:30-38, 6:11-17:19), deconstructing complete storyline into a plurality of episodes (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19 esp. 6-18); constructing a plurality of episodes to relate the complete storyline content (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19 esp. 6-18); implementing in the content server a first episode into a first episodic game module (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19, ref 1708); providing/transmitting the first episodic game module to at least one user computer such that only a [first] portion of the complete storyline content is currently available (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19, ref 1708, i.e. game state dependent), altering in the content server the first portion/remaining of the storyline content to include a game related reference to a current real-world event occurring after first episodic game module is transmitted to at least one user abstract, 1:49-2:50, 3:44-4:38, 6:11-17:19, esp. 4:11-22, 13:45-15:27, figs 1-19), and providing the reference to at least one user after at least one user accesses the first episodic game module (abstract, 1:49-2:50, 3:44-4:38, 6:11-17:19, esp. 4:11-22, 13:45-15:27, figs 1-19), implementing a second episode into an episodic game module (supra) and providing the second game module to at least one user including reference to the real-world event (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, esp. 13:45-15:27, user profiling and seek/obtain clue in real world, figs 1-19, ref 1708-1799), wherein providing includes transmitting from content server to at least one user over network or on a

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computer readable medium readable by the at least one computer wherein reference is provided to at least one computer using a network transport mechanism such as voice mail (abstract, 1:49-2:50, 4:30-38, 6:11-19:43, figs 1-19).

8. Claim 44, 53 and 55-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Miles (6102406). Where storyline includes scavenger hunt plot, Miles disclose a network 22 comprising a content server 20, a plurality of connected user computers 24, a method for providing/delivering [entertainment] content from the content server to at least one user (abstract, 3:26-46, 4:25-6:37, figs 1-6B), including the steps implemented in the content server of receiving a request from a user to game access to an episode of the electronic game (13:48-15:65), delivering an episode of the electronic game to the user (figs 1-6, esp. 4), determining a date for the request received from the user (15:58-65) and permitting access to the requested episode responsive to the determined date being within permitted window for delivery (9:1-15:65); implementing in the content server the storyline content into a plurality of episodes (abstract, 3:26-46, 4:25-6:37, figs 3-6B esp. 4), implementing the episodes into a sequence of episodic game modules (figs 3-6B), for each user transmitting one or more game modules to user's computer on a conditional basis such that the plurality of users reach the same points in the game at approximately same time (figs 3-6B).

9. Claim 44, 53-56 and 58 is rejected under 35 U.S.C. 102(b) as being anticipated by Marks (5755621). Marks is applied to demonstrate scope relating to timing of players reaching same points/stages in game at same time due to all players starting same time, play for same duration and end same time as defined by parameters from content server in evidence therein. Where storyline fails to differentiate from reference due to same process by same structure for same

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purpose of transferring software content to linked users over network, Marks discloses network fig 12 comprising a content server N5, N10, a plurality of connected user computers N20, a method including all steps for providing/delivering [entertainment] content from the content server to at least one user where plot is incremental hand formation in game play (abstract, 3:65-5:26, figs 1-29) including the steps implemented in the content server of receiving a request from a user to game access to an episode of the electronic game (figs 1-29, esp. 13-29), delivering an episode of the electronic game to the user (figs 1-29), determining a date for the request received from the user (fig 13, i.e. date is time or availability of tournament) and permitting access to the requested episode responsive to the determined date being within permitted window for delivery (fig 1-29); a method including implementing in the content server the storyline content into a plurality of episodes (figs 13-29, i.e. decision nodes of pre-determined card pairs in hand formation), implementing the episodes into a sequence of episodic game modules (figs 13-29), for each user transmitting one or more game modules to user's computer on a conditional basis such that the plurality of users reach the same points in the game at approximately same time.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sinclair in view of Miles (6102406) or Shiels (6222925). Sinclair discloses a method comprising claimed features (*supra*) including scheduling intervals for generation and transmission of episodic game modules for the complete storyline content (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19). In the alternative, where Sinclair lacks scheduling intervals for generation and transmission of episodic game modules for the complete storyline content. In related references, Miles (15:63-65) and Shiels (7:62-8:41) disclose a method teaching scheduling intervals for generation and transmission of episodic game modules for the complete storyline content. Miles and Shiels is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The

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level of ordinary skill is as represented by cited references. Because Miles, Shiels and Sinclair each regard method of game play on a gaming machine to provide content incrementally as episodes or segments, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of scheduling intervals for generation and transmission of episodic game modules for the complete storyline content as taught by either Miles or Shiels to improve the method of Sinclair to yield the predictable result of general scheduling manufacture of incremental episodes so as to gain a following of interested users.

14. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinclair in view of background prior art or, in the alternative, over Sinclair in view of Miles or Shiels, as applied to claim 2 above and further in view of background prior art. As would have been interpreted by an artisan, Sinclair or Sinclair in view of Miles or Shiels discloses the method (supra) but lacks discussing responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval (clm 3) and responsive to a technological improvement occurring during a implementation of an episode incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval (clm 4).

However, the instant background discussion of related prior art (1:11-2:9, 7:1-22, fig 1) teaches responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval and responsive to a technological improvement occurring during a implementation of an episode

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incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval by happenstance of timing when an improvement is available. It is also noteworthy that by happenstance of a business decision to delay production so as to incorporate a technological improvement further demonstrates such process being suggested. The background admitted prior art is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the background prior art and Sinclair [in view of Miles, Shiels] each regard method of game play on a gaming machine to provide content incrementally as episodes, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval and responsive to a technological improvement occurring during a implementation of an episode incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval as suggested by background prior art to improve the method of Sinclair or in the alternative, Sinclair in view of Miles or Shiels to yield the predictable result of incorporating an improvement as it becomes available or to render business decision to delay to incorporate it.

15. Claim 8-9 are rejected under 35 U.S.C. 103(a) as unpatentable over Sinclair in view of Miles (6102406) or Shiels (6222925). As best understood by an artisan, Sinclair discloses a

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method comprising claimed features (supra) but lacks periodically scheduled intervals (clm 8) and monthly (clm 9). In related references, as evidence stated above, Miles and Shiels disclose a method teaching periodically scheduled intervals and monthly. Miles and Shiels remain relevant prior art and level of ordinary skill remains as shown by references. Because Miles, Shiels and Sinclair each regard method of game play on a gaming machine to provide content incrementally as episodes or segments, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of periodically scheduled intervals and monthly as taught by either Miles or Shiels to improve the method of Sinclair to yield the predictable result of scheduling transmittal of episodes so as to gain a following of interested users. The particular interval is not a patentable distinction that critically defines over combination of references.

16. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of Eichstaedt (6381594) or Sinclair (6554707). In summary, Shiels discloses claimed method (supra) but lacks voice message. In related references, Eichstaedt (2:31-34) and Sinclair (16:15-19:43) discloses a method teaching a network transport mechanism of voice mail to deliver content. Eichstaedt and Sinclair is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because Eichstaedt, Shiels, and Sinclair each regard method of transmitting content over a network to a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of voice mail as taught by Sinclair or Eichstaedt to improve the method of Shiels to yield the predictable result of

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delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

17. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of Eichstaedt (6381594) or Miles (6102406). In summary, Shiels discloses claimed method (supra) but lacks email message. In related references, Eichstaedt (2:31-34) and Miles (6:17-20) discloses a method teaching a network transport mechanism of email message to deliver content. Eichstaedt and Miles is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Eichstaedt, Miles and Shiels each regard method of transmitting content over a network to a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of email as taught by Eichstaedt or Miles to improve the method of Shiels to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

18. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of Wicks (5942969). In summary, Shiels discloses claimed method (supra) but lacks voice message. In related reference, Wicks (ref 21) discloses a method teaching a network transport mechanism of pager. Wicks is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In*

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re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because Wicks and Sinclair each regard method of transmitting content over a network between server and a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of pager as taught by Wicks to improve the method of Shiels to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

19. Claims 17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of Miles (6102406). In summary, Shiels discloses claimed method (*supra*) but lacks a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page (clm 17), accessing a predetermined web site (clm 20), requesting a specific search term (clm 21), wherein episodic content is stored within a third party website that is content related to the storyline and the users are directed to the website to discover the episodic content (clm 22) and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content (clm 23). In a related reference, where notification is at least a cookie, where advertisers/sponsors are third party and where hypertext link accesses a website, Miles (abstract, 3:26-46, 4:26-5:7, 5:51-11:7, 11:35-60, 12:41-15:65, figs 1-6B, esp. 3-6B) discloses a method (*supra*) teaching a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page (7:1-8:63); wherein the user action is accessing a predetermined web site (9:1-12:29, 12:41-15:65, figs 3-6B); wherein the user action is requesting a specific search term (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B,

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i.e. searching via search engine and/or use of "FIND ON PAGE" utility on a website inherent in browser such as Internet Explorer to locate query); wherein episodic content is stored within a third party website that is content related to the storyline (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B) and the users are directed to the website to discover the episodic content and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B). Miles is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Miles and Shiels each regard method of transmitting content over a network to a computer where user performs action to advance game, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page, accessing a predetermined web site, requesting a specific search term, wherein episodic content is stored within a third party website that is content related to the storyline and the users are directed to the website to discover the episodic content and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content as taught by Miles to improve the method of Shiels to yield the predictable result of delivering content to user upon user action and to generate revenue stream based on users interactions at predefined websites.

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20. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of Forrest (5697075). In summary, Shiels discloses claimed method (*supra*) but lacks wherein the user action is calling a predefined telephone number. In a related reference, Forrest (abstract, 2:27-3:35, 3:58-4:28, 11:53-58, figs 1-5) discloses a method teaching wherein the user action is calling a predefined telephone number. Forrest is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Forrest and Shiels each regard method of delivering content based on user action, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of calling a predefined telephone number as taught by Eichstaedt or Sinclair to improve the method of Shiels to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

21. Claim 48 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sinclair in view of Miles. Sinclair discloses the method (*supra*) including fabricated news story related to real world events in so far as Sinclair teaches profiling a user to add degree of reality or mapping between the 'real world' and the 'virtual world' can add drama and realism to the fantasy which enhances the impact where introduction of the real world data affects game state (1:49-2:50, 11:14-12:46, 13:45-17:18) that is same structure performing same function. The process of relating real world events being a fabricated

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news story solves no stated problem and performs no function not performed by Sinclair that provides current real world events based on profiling for incorporation into game to add drama. In the alternative, where Sinclair lacks wherein the reference is a fabricated news story related to real world events, the particular manner of delivering/ providing real world event fails to critically distinguish over Sinclair where fabricated news story is a form of presentation that regards design choice. In a related reference, Miles discloses a method (supra) teaching providing/transmitting episodes to users who access websites in response to clues to advance game where the information on the websites of sponsors is current world event thereby suggesting a fabricated news story in so far as the content on website relates to storyline of game. Miles remains relevant prior art and level of skill remains as stated above. In consideration of KSR, it would have been obvious to an artisan at a time prior to the invention to apply wherein the reference is a fabricated news story related to real world events as suggested by Miles to improve the method of Sinclair to yield the predictable result of presenting real world content to user in an episode of game. In essence, the manner of presentation fails to critically distinguish over combination when taken as a whole at a time prior to the invention.

Response to Arguments

22. Applicant's arguments, see page 10, filed March 26, 2010, with respect to nonstatutory subject matter have been fully considered and are persuasive. The rejection of claims 1-4, 6-13, 17-24, 42-44 and 47-58 has been withdrawn.

23. Applicant's arguments, see page 10, filed March 26, 2010, with respect to the rejection(s) of claim(s) 1-4, 6-13, 17-24, 42-44 and 47-58 under 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration,

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a new ground(s) of rejection is made in view of reconsideration of scope of invention and references to background prior art, Eichstaedt, Forrest, Miles, Shiels, Sinclair and Wicks.

Conclusion

24. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nancy Drew Mystery games are periodic episodic games available for delivery from web/internet such as stated in instant background prior art.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/

Primary Examiner, Art Unit 3714